

IN THE CLAIMS

Please cancel Claims 2-13 and 20-25 without prejudice or disclaimer of subject matter.

REMARKS

Claims 1 and 14-19 remain in this application. Claims 2-13 and 20-25 have been canceled without prejudice or disclaimer of subject matter. The title and specification have been amended in response to the Examiner's objections thereto.

Claims 1 and 14 are independent.

Claims 1, 14 and 16-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,641,997 (Ohta et al.), and Claims 1, 14, 15 and 17, as being anticipated by U.S. Patent 5,656,098 (Ishikawa et al.).

Independent Claim 1 is directed to an encapsulant resin member for a semiconductor. According to Claim 1, an additive dissolved in the encapsulant resin has a concentration gradient in the direction of the thickness of the resin.

Independent Claim 14 is directed to a semiconductor element encapsulated with an encapsulant resin. According to Claim 14, an additive dissolved in the encapsulant resin has

a concentration gradient in the direction of the thickness of the resin.

Ohta relates to a plastic-encapsulated semiconductor device in which a semiconductor chip is positioned between encapsulating sheets, which each have a surface that is highly adhesive, and one that is less so. The highly adhesive surfaces are those which contact the chip, while the other surfaces contact a mold. Encapsulation is performed by molding.

Applicants respectfully point out that, in order to be relied upon as meeting a claim recitation, a reference must contain a clear teaching of the recitation in question. That is, the reference's disclosure must be such that, when read by a person of ordinary skill, the reader would have no doubt that the recitation is in that disclosure. A mere possibility is not sufficient. *Ohta* discusses a large number of resins, and a large number of additives. Some of these additives are discussed in terms which make it clear that the additive is in the form of granules, which would presumably be suspended, rather than dissolved, in the resin (see, for example, col. 9, lines 11-22). Others are discussed in terms which, in Applicants' judgment, leave it unclear whether the additive is suspended in the resin, or is mixed

in in some other fashion. In Applicants' view, nothing has been found, or pointed out, in *Ohta* that would provide the required clear teaching of an additive dissolved in the resin.

The portions of that patent specifically cited in the Office Action, in particular, do not state that a solution is involved. Col. 10, line 55, through col. 11, line 8, and Fig. 4, which is discussed in that passage, relate to a process in which a plurality of sheets of resin, each containing an additive but in different concentrations, are placed on top of one another and melted together, to produce a sheet having different concentrations of the additive in different portions of the composite sheet. Nothing in this passage or in Fig. 4, however, is seen to make clear that the additive is in the form of a solute in the resin, rather than being merely granules suspended in the resin. Col. 4, lines 45-47, discuss mentions various purposes filled by the additive, but without specifying whether there is a solution involved or merely a suspension. Col. 18, lines 34-38, mentions that the distribution of a colorant (as an additive) can be changed. Col. 22, lines 33 and 34, mentions a filler being treated with a silane coupling agent before being mixed with the resin. Col. 17,

lines 55-58, discusses inner and outer portions of the resin, having differing amounts of a curing accelerator, but does not specify whether the accelerator is in solution or is present in the form of suspended granules. For these reasons, Applicants traverse the rejection of Claims 1 and 14 based on *Ohta*, and submit that Claims 1 and 14 are allowable over *Ohta*.

Ishikawa '098 relates to a photovoltaic conversion device, and a method for its production, in which electrodes and a surface protection layer are adjacent to a semiconductor layer. Granules of a material different from those of the surface protection layer are in the surface protection layer. Applicants submit, however, that nothing in *Ishikawa '098* would teach or suggest an additive dissolved in a resin, as recited in Claims 1 and 14. The portions of that patent cited by the Examiner for such a teaching are not on point: each of them refers to an additive 1102a, 1102b which in fact is present in the form of granules (see col. 25, line 54: "Reference numerals 1102a and 1102b represent granules,.... (emphasis added)). For at least that reason, Applicants submit that the rejection based on *Ishikawa '098* is not well based, and should also be withdrawn.

A review of the other art of record has failed to reveal anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from independent Claim 14, discussed above, and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All

correspondence should continue to be directed to our below
listed address.

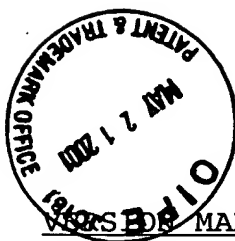
Respectfully submitted,

22 P. Diana
Attorney for Applicants

Registration No. 29,286

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

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PLEASE BE MARKED TO SHOW CHANGES TO SPECIFICATION

Page 8, line 23, through page 9, line 7:

--Fig. 1 is a schematic sectional view of a solar cell module (semiconductor device) of the present invention. In Fig. 1, reference numeral 100 designates the solar cell module, 101 a photovoltaic element, 102 a transparent encapsulant resin on the front surface side, 103 a transparent front surface member located in the outermost surface, 104 an encapsulant resin on the back surface side, [and] 105 a back surface member, and 106 current collector electrodes. Light from the outside is incident [into] onto the front surface member 103 and passes therethrough to reach the photovoltaic element 101, and the generated electromotive force is taken out via output terminals (not shown).--.